

**UNITED STATES DEPARTMENT OF COMMERCE****Patent and Trademark Office**Address: COMMISSIONER OF PATENTS AND TRADEMARKS  
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/411,568	10/04/99	CONRAD	C INGA. 004/C/C

MARK R WISNER C/O WISNER & ASSOCIATES 2925 BRIARPARK SUITE 930 HOUSTON TX 77042	HM12/1221	EXAMINER MARTINELL, J
		ART UNIT PAPER NUMBER 1633 6.
		DATE MAILED: 12/21/00

Please find below and/or attached an Office communication concerning this application or proceeding.

**Commissioner of Patents and Trademarks**

<b>Office Action Summary</b>	Application No.	Applicant(s)
	09/411,568	CONRAD, CHARLES A.
	Examiner James Martinell	Art Unit 1633

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 04 October 1999.

2a) This action is FINAL.                    2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 1-15 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 1,5,6, and 11-14 is/are rejected.

7) Claim(s) 2-4,7-10, and 15 is/are objected to.

8) Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

11) The proposed drawing correction filed on \_\_\_\_\_ is: a) approved b) disapproved.

12) The oath or declaration is objected to by the Examiner.

#### Priority under 35 U.S.C. § 119

13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

a) All b) Some \* c) None of:

1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_ .
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

14) Acknowledgement is made of a claim for domestic priority under 35 U.S.C. & 119(e).

#### Attachment(s)

15) Notice of References Cited (PTO-892)

16) Notice of Draftsperson's Patent Drawing Review (PTO-948)

17) Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_ .

18) Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_ .

19) Notice of Informal Patent Application (PTO-152)

20) Other: *Notice to Comply to Sequence Rules* .

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The instant application does not comply with the Sequence Rules (see 37 CFR §§ 1.821-1.825). The sequences in the Table on pages 39-40 do not comply with the Sequence Rules. See the attached notice to comply with the sequence rules. Any response to this Office action must include those items listed on the notice to comply with the sequence rules in order to be completely responsive to this Office action. The period for response to the notice to comply with the sequence rules runs concurrently with the period to respond to this Office action.

This application has been filed with informal drawings which are acceptable for examination purposes only. Formal drawings will be required when the application is allowed.

The disclosure is objected to because of the following informalities.

- (a) The first sentence of the application should contain all of the data in connection with the parent applications (see MPEP 201.11).

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(b) The status of each of the parent applications should be updated.

(c) At page 1, line 23, "complimentary" is a typographical error and should be changed to --complementary--.

Appropriate correction is required.

The abstract of the disclosure is objected to because it is too long and is more than one paragraph. Correction is required.

See MPEP § 608.01(b).

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 5 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

(a) The recitation of "designed to form a stem-loop intermediate . . . forming the stem" is vague and

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indefinite because it is not clear whether the nucleic acid does what it is "designed" to do. The claim should be amended to describe the function of the molecule and delete the intent behind the construction of the molecule.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 5, 6, and 11-14 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Nabel et al (WO 95/29993 (11/9/95)). Claim 6 of the reference describes a vector that has all of the characteristics of the vectors mentioned in the claims. It is noted here that any sequence may serve as a primer binding site.

Claims 2-4, 7-10, and 15 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten

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in independent form including all of the limitations of the base claim and any intervening claims.

Certain papers related to this application may be submitted to Group 1600 by facsimile transmission. Papers should be faxed to Art Unit 1633 at (703) 308-4242. The faxing of such papers must conform with the rules published in the Official Gazette, 1156 OG 61 (November 16, 1993).

Any inquiry concerning this communication should be directed to J. Martinell at telephone number (703) 308-0296.



JAMES MARTINELL, Ph.D.  
SENIOR LEVEL EXAMINER